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## NOTICE OF ALLOWANCE AND FEE(S) DUE

5409 7590 11/17/2008

SCHMEISER, OLSEN & WATTS  
22 CENTURY HILL DRIVE  
SUITE 302  
LATHAM, NY 12110

EXAMINER

GUZMAN, APRIL S

ART UNIT

PAPER NUMBER

2618

DATE MAILED: 11/17/2008

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/568,336

02/13/2006

Mikio Fukuda

SAIT4480

3346

TITLE OF INVENTION: PORTABLE TELEPHONE USING BONE CONDUCTION DEVICE

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	\$755	\$300	\$0	\$1055	02/17/2009

**THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.**

**THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.**

### HOW TO REPLY TO THIS NOTICE:

#### I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.**

# **PART B - FEE(S) TRANSMITTAL**

**Complete and send this form, together with applicable fee(s), to: Mail Mail Stop ISSUE FEE  
Commissioner for Patents  
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**INSTRUCTIONS:** This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

5409 7590 11/17/2008  
**SCHMEISER, OLSEN & WATTS**  
22 CENTURY HILL DRIVE  
SUITE 302  
LATHAM, NY 12110

## **Certificate of Mailing or Transmission**

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/568,336	02/13/2006	Mikio Fukuda	SAIT4480	3346
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TITLE OF INVENTION: PORTABLE TELEPHONE USING BONE CONDUCTION DEVICE

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nonprovisional	YES	\$755	\$300	\$0	\$1055	02/17/2009
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EXAMINER	ART UNIT	CLASS-SUBCLASS
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GUZMAN, APRIL S	2618	455-575100
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1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

- ☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
- ☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list

- (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, 1 \_\_\_\_\_
- (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed. 2 \_\_\_\_\_
- 3 \_\_\_\_\_

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE (B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent) : ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. The following fee(s) are submitted:

- ☐ Issue Fee
- ☐ Publication Fee (No small entity discount permitted)
- ☐ Advance Order - # of Copies \_\_\_\_\_

4b. Payment of Fee(s); (Please first reapply any previously paid issue fee shown above)

- ☐ A check is enclosed.
- ☐ Payment by credit card. Form PTO-2038 is attached.
- ☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number \_\_\_\_\_ (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

- ☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. ☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature \_\_\_\_\_

Date \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Registration No. \_\_\_\_\_

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,336	02/13/2006	Mikio Fukuda	SAIT4480	3346
5409	7590	11/17/2008	EXAMINER	
SCHMEISER, OLSEN & WATTS 22 CENTURY HILL DRIVE SUITE 302 LATHAM, NY 12110			GUZMAN, APRIL S	
			ART UNIT	PAPER NUMBER
			2618	
DATE MAILED: 11/17/2008				

## Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 0 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 0 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

**Notice of Allowability**

Application No.

10/568,336

Applicant(s)

FUKUDA, MIKIO

Examiner

Art Unit

APRIL S. GUZMAN

2618

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 07/29/2008.
2. ☒ The allowed claim(s) is/are 1-15.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \* Certified copies not received: \_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).**
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),  
Paper No./Mail Date 02/13/2006
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_.
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

The Examiner acknowledges the receipt of the Applicant's amendment filed on 07/29/2008. Claims 1-15 have been amended. **Claims 1-15** are therefore still currently pending in the present application.

### *Allowable Subject Matter*

**Claims 1-15** are allowed.

The following is an examiner's statement of reasons for allowance:

Consider **claim 1**, the best prior art found during the examination of the present application, **Lee et al. (WO 2004/032566 A1)**, fail to specifically teach, disclose or suggest a portable telephone using a bone conduction device comprising: a bone conduction device having an outer surface edge; a housing having a concave portion with a bottom portion and an inner edge surface, said concave portion of said housing being larger in diameter than said bone conduction device when said bone conduction device is operatively positioned therein; *a cushioning material operatively disposed between said inner edge surface of said concave portion of said housing and said outer surface edge of said bone conduction device such that said bone conductive device is supported in the concave portion of the housing only by the cushioning material disposed around the bone conduction device*; a gap formed between said bone conduction device and said bottom portion of said concave portion of said housing such that *no cushioning material is disposed in said gap, thereby reducing the thickness of the*

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*portable telephone*; and a vibration surface of said bone conduction device positioned to be slightly extended outward from said housing by said cushioning material.

Lee et al. teach a bone conduction speaker using a vibrating plate wherein the bone conduction speaker comprises: a body having a shape of a cylinder with an upper portion and a lower portion opened; a mastoid having a lower diameter and an upper diameter, wherein the lower diameter is relatively smaller than the upper diameter; a vibrating plate being inserted to a lower portion of the mastoid to close an upper opening portion of the body, wherein the vibrating plate is made of an elastic material; an auxiliary vibrating plate being inserted to a lower portion of the mastoid under the vibrating plate which is inserted to the mastoid (page 6 lines 17-25, and page 18 lines 5-18).

These teachings clearly differ from the present application, therefore claim 1 is considered novel and non-obvious over the prior art and therefore claim 1 is allowed. Claims 4-6, 10 and 13 depend on allowable claim 1, therefore these claims are also allowed.

Consider **claim 2**, the best prior art found during the examination of the present application, **Lee et al. (WO 2004/032566 A1)**, fail to specifically teach, disclose or suggest a portable telephone comprising: a bone conduction device having a diameter and an outer surface edge; a housing having a surface and a through-hole portion having a diameter and a surface, said through-hole portion being operatively positioned in the housing, wherein said bone conduction device is operatively positioned in said through-hole portion; *cushioning material operatively disposed between said surface of said through-hole portion and said outer surface edge of said bone conduction device such that said bone conductive device is supported in said through-hole portion of the housing only by the cushioning material disposed around the bone*

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*conduction device positioned within said through- hole portion, thereby reducing the thickness of the portable telephone; and, a vibration surface of said bone conduction device extending outward from said housing.*

Lee et al. teach a bone conduction speaker using a vibrating plate wherein the bone conduction speaker comprises: a body having a shape of a cylinder with an upper portion and a lower portion opened; a mastoid having a lower diameter and an upper diameter, wherein the lower diameter is relatively smaller than the upper diameter; a vibrating plate being inserted to a lower portion of the mastoid to close an upper opening portion of the body, wherein the vibrating plate is made of an elastic material; an auxiliary vibrating plate being inserted to a lower portion of the mastoid under the vibrating plate which is inserted to the mastoid (page 6 lines 17-25, and page 18 lines 5-18).

These teachings clearly differ from the present application, therefore claim 2 is considered novel and non-obvious over the prior art and therefore claim 2 is allowed. Claims 3, 11-12, and 14-15 depend on allowable claim 2, therefore these claims are also allowed.

Consider **claim 7**, the best prior art found during the examination of the present application, **Lee et al. (WO 2004/032566 A1)**, fail to specifically teach, disclose or suggest a portable telephone comprising: a housing having a device installation opening; a bone conduction device; *a device holder made of a resilient material wherein said device holder is constructed of a container portion and a fixing portion*, wherein said container portion carries said bone conduction device therein such that *said bone conductive device is supported in said container portion only by cushioning material disposed around the bone conduction device, thereby reducing the thickness of the portable telephone*, and wherein said fixing portion is

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fixedly mounted on an inner surface of said device installation opening of said housing of the telephone and said bone conduction device extends from said housing; and a gap formed between said bone conduction device and said housing.

Lee et al. teach a bone conduction speaker using a vibrating plate wherein the bone conduction speaker comprises: a body having a shape of a cylinder with an upper portion and a lower portion opened; a mastoid having a lower diameter and an upper diameter, wherein the lower diameter is relatively smaller than the upper diameter; a vibrating plate being inserted to a lower portion of the mastoid to close an upper opening portion of the body, wherein the vibrating plate is made of an elastic material; an auxiliary vibrating plate being inserted to a lower portion of the mastoid under the vibrating plate which is inserted to the mastoid (page 6 lines 17-25, and page 18 lines 5-18).

These teachings clearly differ from the present application, therefore claim 7 is considered novel and non-obvious over the prior art and therefore claim 7 is allowed. Claims 8-9 depend on allowable claim 7, therefore these claims are also allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: see PTO-892 Notice of References Cited.



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Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Hand-delivered responses** should be brought to

Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April S. Guzman whose telephone number is 571-270-1101. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Anderson can be reached on 571-272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/568,336

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/April S. Guzman/

Examiner, Art Unit 2618

/Edward Urban/

Supervisory Patent Examiner, Art Unit 2618